

REMARKS/ARGUMENTS

In response to the Restriction Requirement mailed August 7, 2003, Applicants elect with traverse Group VI, claims 1, 2, 10, 14-17, and 18-26, drawn to methods of preventing or treating HIV infection by screening for stem cells that have a beneficial gene that alters the ability of HIV to infect cells, and transplanting the cells, wherein the beneficial gene is a receptor or co-receptor for HIV entry and wherein the receptor is CCR5. At the request of the Examiner, Applicants also elect with traverse the species umbilical cord blood for claim 18. Applicants traverse the restriction of groups I-VI, each group being drawn to methods of preventing or treating HIV infection by screening for stem cells that have a beneficial gene that alters the ability of HIV to infect cells, and transplanting the cells.

The foregoing election is made with traverse, as Groups I-VI set forth by the Examiner all stem from a common concept and theory, and are thus related. As indicated above, Group VI is drawn to methods of preventing or treating HIV infection by screening for stem cells that have a beneficial gene, *i.e.*, a beneficial CCR5 gene, that alters the ability of HIV to infect cells, and transplanting the cells. The methods of Groups I-V are also directed to methods of preventing or treating HIV by screening for stem cells that have a beneficial gene and transplanting those stem cells. In addition, the methods of Groups I-V include same screening and transplantation steps found in the methods of Group VI. As such, prosecution of the claims of Groups I-VI would not place a substantially greater burden on the Examiner. At the very least, groups IV-VI are all directed to screening for beneficial genes amongst receptors or co-receptors for HIV entry and should be examined together.

According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, *e.g.*, MPEP at 803. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show that the restricted groups have a separate classification; have acquired a separate status in

Appl. No. 09/998,832
Amdt. dated October 16, 2003
Reply to Office Action of August 7, 2003

PATENT

the art, if the groups are classified together; or that searching would require different fields of search (MPEP at 808.02).

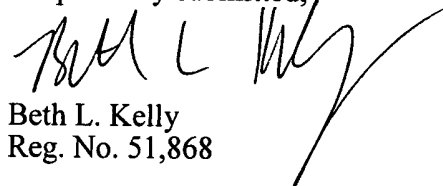
Applicants respectfully submit that Groups I-VI can readily be searched without undue burden because a search for one group will identify art pertaining to the other groups. Applicants therefore respectfully request that the Examiner withdraw the Restriction Requirement and consider Groups I-VI together.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


Beth L. Kelly
Reg. No. 51,868

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
BLK:blk
60051914 v1